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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,253	03/01/2002	Barbara A. Rincavage	RINCAVAGE-1	4031
25101	7590	06/08/2011	EXAMINER	
Philip D. Freedman PC 1449 Drake Lane Lancaster, PA 17601			RINES, ROBERT D	
ART UNIT	PAPER NUMBER			
	3623			
MAIL DATE	DELIVERY MODE			
06/08/2011	PAPER			

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA A. RINCAVAGE and CYNTHIA E. RINCAVAGE

Appeal 2011-007840
Application 10/086,253
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejections of claims 21-40. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.¹

PROSECUTION HISTORY

The instant application was previously the subject of Appeal Number 2009-004309. In that Appeal, a decision on that appeal was mailed on September 3, 2009, affirming the rejections of all pending claims 1-20. Subsequently, Appellants filed a Request for Continued Examination, cancelling the previously appealed claims 1-20, and presenting new claims 21-40, the rejection of which they now appeal.

THE INVENTION

Appellants' claimed invention relates to a prescription fulfillment method and system for tracking the proper execution of a medical prescription from the time it is prescribed by a physician to the time it is filled by a pharmacist and received by the recipient in the pharmacy. (Abs.)

Independent claim 21, which is deemed to be representative, reads as follows:

21. A prescription fulfillment method, comprising:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed Oct. 11, 2010) and Reply Brief (Reply Br., filed Feb. 28, 2011), and the Examiner's Answer ("Ans.", mailed Jan. 18, 2011).

- entering an unfilled prescription prescribed by a physician or medical service provider into a processing center wherein the prescribed prescription comprises at least medication brand or dosage;
- retrieving the unfilled prescription from the processing center;
- filling the prescribed prescription by a pharmacist, wherein the filled prescription is different from the retrieved prescription in respect of at least one of medication brand and dosage;
- entering the filled and different medication brand or dosage into the processing center in fulfillment of the prescribed prescription for review by the prescribing physician or medical service provider.

THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Keresman, III et al. (“Keresman”)	2001/0047281 A1	Nov. 29, 2001
Borsand et al. (“Borsand”)	2003/0074225 A1	Apr. 17, 2003
Denny	2004/0107117 A1	Jun. 03, 2004

The Examiner rejected claims 21, 22, 27-32, and 37-40 under 35 U.S.C. § 103(a) as being obvious over Denny and Borsand. Additionally, claims 23-26 and 33-36 are rejected under 35 U.S.C. § 103(a) as being obvious over Denny, Borsand, and Keresman.

ISSUES

Appellants argue that the combination of Denny and Borsand fails to teach or suggest the step of “entering the filled and different medication brand or dosage into the processing center in fulfillment of the prescribed prescription for review by the prescribing physician or medical service

provider,” as recited by independent claim 21. (App. Br. 10.) Similarly, with regard to independent system claim 31, Appellants argue that the combination of Denny and Borsand fails to teach or suggest that “the processing center accepts filled prescription information through the network from the pharmacist in fulfillment of the prescribed information but that differs in at least one respect from medication brand or dosage of the prescribed prescription information.” (App. Br. 10.)

To support their arguments, Appellants argue that the Examiner has failed to provide Appellants with a *prima facie* case of obviousness since Appellants’ are unable to find support in Borsand for the passage “wherein the filled prescription is different from the retrieved prescription in respect of at least one or medical brand and dosage,” where the Examiner relied on Borsand for that feature. (App. Br. 10; *see also* Reply Br. 7-8.) Additionally, Appellants argue that the Denny reference is not prior art since its filing date, June 3, 2004, is after the March 1, 2002 filing date of the present application. (App. Br. 12; *see also* Reply Br. 9-10.)

Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Thus, the issues arising from the respective positions of Appellants and the Examiner are:

1. Does the combination of Denny and Borsand teach or suggest all the limitations of independent claims 21 and 31, and, as such, makes obvious

the subject matter of claims 21, 22, 27-32, and 37-40 under 35 U.S.C. § 103(a)?

2. Does the combination of Denny, Borsand, and Keresman, teach or suggest all the limitations of dependent claims 23-26 and 33-36 under 35 U.S.C. § 103(a)?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

Denny

1. Denny was filed as U.S. Application 10/722,276 on November 25, 2003, and published on June 3, 2004 as publication US 2004/0107117 A1.

2. Denny claims priority as a continuing application to U.S. Application 10/158,259, filed on May 29, 2002, now U.S. Patent 6,687,676, which is a continuation of U.S. Application 09/400,498, filed on September 21, 1999.

3. Denny is directed to “a prescription verification system [which] . . . receives prescription information including a prescribed drug intended to treat a condition associated with a patient.” (¶ [0010].)

4. Denny describes prescription information as “a dosage level for the prescribed drug, the drug label contents and any applicable notes to be included on the bottle, a unique health care provider code identifying the

health care provider who input the prescription information, and a patient code uniquely identifying the patient.” (¶ [0010].)

5. The pharmacist enters a unique code identifying a prescription identifying the patient, the patient prescription information is received by the pharmacy system from the host, and the prescription is filled by the pharmacist. Subsequently, a confirmation code indicative of a prescription being filled is entered into the system by the pharmacist and sent to the host. (¶ [0041].)

6. The system determines whether or not the data received are valid based upon querying the prescription database. When the information received from the pharmacy system corresponds to prescription information maintained in the host system, a signal identifying a valid prescription is sent to either a health care provider or back to the pharmacy system. Conversely, when the information received from the pharmacy system does not correspond to the prescription information in the host system, a signal identifying an invalid prescription is sent. (¶ [0053].)

Borsand

7. Borsand is directed to a pharmaceutical information tracking system which can check for unfavorable pharmaceutical interactions and allergic reactions, prevent misuse of a prescription, monitor the filling and re-filling of a prescription, as well as cancel a prescription after it has been issued by a provider. (Abs.)

8. Borsand allows users to monitor pharmacists to prevent changes made to a medical prescription that would alter the filled prescription from

the original prescription. Specifically, Borsand discloses that, “it would be desirable if a pharmacist could be prevented from filling a prescription at half strength but twice the volume and cost. It would also be desirable if a [sic] pharmacists could be prevented from filling redundant prescriptions from two or more providers.” (¶ [0005].)

9. The pharmacist can modify the prescription after reviewing the prescription as it relates to pharmaceutical interactions, allergies, or other patient attributes that could affect the desirability of filling a particular prescription. (¶ [0087].)

10. The pharmacist enters an electronic representation of a filled prescription into the system once the pharmacist has evaluated the prescription in the context of any attributes or characteristics that could impact the desirability of a particular pharmaceutical. (¶ [0084], [0085] and [0086].)

11. Prescription information includes strength, quantity and the directions for taking the pharmaceutical. (¶ [0064].)

12. Borsand describes that after a prescription is filled with a modification, an event is triggered which provides the provider (i.e., prescribing doctor) with the ability to cancel or further modify the prescription. (¶ [0120] and [0121].)

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.’’ *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

ANALYSIS

*Claims 21, 22, 27-32, and 37-40 rejected under 35 U.S.C. § 103(a)
as being obvious over Denny and Borsand.*

Independent claims 21 and 31

We are not persuaded by Appellants’ arguments and find that Denny describes a system which determines whether or not the data received from a pharmacist are valid based upon querying the prescription database. After this determination, a signal is sent identifying whether or not the information received from the pharmacy system corresponds to prescription information maintained in the host system. (FF 6.) This determination is based on a confirmation code, sent to the host system, indicative of a prescription being filled by the pharmacist and then compared against the prescription information maintained at the host to determine whether the prescription filled matches the original prescription prescribed. (FF 5, 6). Accordingly, since Denny enters information about how a prescription was filled, this prescription information would also include how a prescription entered is different from the prescribed prescription.

Even assuming that Denny does not explicitly disclose entering any form of information regarding how a pharmacist may have changed the prescription beyond the “non-discretionary yes/no” response, as Appellants’ contend Denny discloses (Reply Br. 7), the rejection is based on the combination of Denny and Borsand. (Ans. 4-6.) We find that Borsand

teaches that a pharmacist can modify the prescribed prescription after reviewing the prescription as it relates to any pharmaceutical interactions, allergies, or other patient attributes that could affect the desirability of filling that prescription. (FF 9.) Additionally, Borland describes that a pharmacist enters an electronic representation of a filled prescription once the pharmacist has evaluated the prescription. (FF 10.) Further, Borsand teaches that after a prescription is filled with a modification, the medical service provider (i.e., prescribing doctor) is notified, and given the option of cancelling or further modifying the prescribed prescription. (FF 12.)

Accordingly, we find that a person of ordinary skill in the art would have appreciated from a reading of Denny and Borsand, that in order to transmit a signal identifying whether a prescription filled is valid or invalid, based upon whether or not the data received from the pharmacist match the original prescription prescribed in the host database (FF 8), the pharmacist must enter information regarding how a prescription filled may be different from the original prescription prescribed. Thus, a person of ordinary skill in the art would have known from Borsand that the information entered includes strength, quantity and any alterations or modifications made to the prescription by the pharmacist (FF 9, 10, 11), and applied this technique to Denny when entering any form of information regarding how a pharmacist may have filled the prescription differently. (FF 4, 5, 6.)

Therefore, we find that the combination of Denny and Borsand teaches or suggests the step of “entering the filled and different medication brand or dosage into the processing center in fulfillment of the prescribed

prescription for review by the prescribing physician or medical service provider,” as generally recited by independent claims 21 and 31.

Additionally, Appellants argue that the Examiner has failed to demonstrate a *prima facie* case of obviousness since Appellants are unable to find support in Borsand for the passage “wherein the filled prescription is different from the retrieved prescription in respect of at least one or medical brand and dosage,” where the Examiner relied upon Borsand for this feature. (App. Br. 10; *see also* Reply Br. 7-8.) We are not persuaded by Appellants’ argument, and find that the passage Appellants are unable to find support for in the Borsand reference is in fact Appellants’ own claim language recited by independent claim 1. (App. Br. 14.)

While we agree with Appellants that Borsand does not provide the contested passage *ad verbum*, we cannot agree with Appellants that the evidence provided in Borsand, and cited by the Examiner’s rejection (Ans. 5-6), does not otherwise render this passage obvious for the reasons discussed *supra*. Accordingly, for these reasons, and the reasons discussed *supra*, we find Appellants’ arguments to be unpersuasive.

Lastly, Appellants argue that the Denny reference is not prior art since its filing date of June 3, 2004 is after the March 1, 2002 filing date of the present application. (App. Br. 12; *see also* Reply Br. 9-10.) We cannot agree.

Denny was published on June 3, 2004 (FF 1), but Denny also claims priority as a continuing application to U.S. Application 10/158,259, filed on May 29, 2002, now U.S. Patent 6,687,676, which is a continuation of U.S. Application 09/400,498, filed on September 21, 1999. (FF 2.) If Appellant

wishes to show that Denny, and apparently Borsand (Reply Br. 10, n.1.), cannot rely on their parent applications for priority, Appellants have the burden of proof. Appellants have not provided any compelling arguments or factual evidence as to why Denny cannot rely on its earliest effective filing date of September 21, 1999 under 35 U.S.C. § 120. (FF 2.) Therefore, we find that Denny is available as prior art under 35 U.S.C. § 102(e) as of its earliest effective filing date of September 21, 1999, and as such prior art for purposes of 35 U.S.C. § 103(a) as of the same date. *See MPEP § 2141.01.*

Accordingly, we sustain the Examiner's rejection of Appellants' independent claims 21 and 31 as obvious over Denny and Borsand under 35 U.S.C. § 103(a).

Dependent claims 22, 27-30, 32, and 37-40

Appellants do not separately argue claims 22, 27-30, 32, and 37-40, which depend from independent claims 21 and 31, respectively, and so we sustain the rejection of claims 22, 27-30, 32, and 37-40 under 35 U.S.C. § 103(a) as obvious over Denny and Borsand for the same reasons we found as to claims 21 and 31 *supra*.

ISSUE 2

Claims 23-26 and 33-36 rejected under 35 U.S.C. § 103(a) as being obvious over Denny, Borsand, and Keresman.

Appellants do not separately argue claims 23-26 and 33-36, which depend from independent claims 21 and 31, respectively, and so we sustain the rejection of claims 23-26 and 33-36 under 35 U.S.C. § 103(a) as being

obvious over Denny, Borsand, and Keresman for the same reasons we found as to claims 21 and 31 *supra*.

CONCLUSIONS OF LAW

1. We conclude that the combination of Denny and Borsand teaches or suggests all the limitations of independent claims 21 and 31, and as such, makes obvious the subject matter of claims 21, 22, 27-32, and 37-40 under 35 U.S.C. § 103(a).

2. We conclude that the combination of Denny, Borsand, and Keresman, teaches or suggests all the limitations of dependent claims 23-26 and 33-36 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 21-40 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

AFFIRMED

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